

REMARKS

Claims 1, 3 through 6, 13, and 15 through 18 are currently pending in the application.

This amendment is in response to the Office Action of June 20, 2006.

Information Disclosure Statement

Applicant notes the filing of an Information Disclosure Statement herein on June 27, 2006, and notes that a copy of the PTO-1449 was not returned with the outstanding Office Action. Applicant respectfully requests that the information cited on the PTO-1449 be made of record herein.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Oh (U.S. Patent 5,352,107) in View of Taniguchi et al. (U.S. Patent 6,221,690)

Claims 1, 3 through 6, 13, and 15 through 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oh (U.S. Patent 5,352,107) in view of Taniguchi et al. (U.S. Patent 6,221,690). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Turning to the cited prior art, the Oh reference teaches or suggests the use of an apparatus for sensing incomplete molding of an automold system in process for molding semiconductor packages.

Taniguchi describes a semiconductor package and production method thereof. Specifically, Taniguchi describes a semiconductor package production method where a solder resist 3 is formed on the top surface side of a BGA (ball and grid array) substrate (col. 3, lines

35-36). This solder resist is preferably one that can be removed by a laser (col. 4, line 40-42). The laser can be selected from the fundamental wave of a YAG laser, the second harmonic, the third harmonic, and fourth harmonic of the YAG laser, an excimer laser, and so on (col. 5, lines 47-51). Lastly, an encapsulating resin can be used to encapsulate the substrate (col. 6, lines 57+).

Applicant asserts that any combination of the Oh reference in view of the Taniguchi reference fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of independent claims 1 and 13 because any combination of such cited prior art fails to teach or suggest all the claim limitations of independent claims 1 and 13. Applicant asserts that any combination of the cited prior art fails to teach or suggest the claim limitations of independent claims 1 and 13 calling for “removing at least a portion of the resist from the substrate using the laser used in the automolding system”, “placing the substrate in the molding portion of the automolding system for encapsulation of a portion thereof”, “laser etching the resist from at least a portion of the surface of the substrate using the laser in the automolding system”, and “encapsulating the substrate in the molding portion of the automolding system”.

Applicant respectfully submits there is no suggestion or motivation, either the Oh reference or Taniguchi, to modify any of the reference or to combine reference teachings to form the claimed invention to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. The Oh reference merely teaches or suggests the use of automolding systems while the Taniguchi reference does not suggest or provide evidence showing that its teachings of laser removal of resist, when combined with an automolding system, would provide a more efficient automation in manufacture. Applicant respectfully submits that such analysis is merely hindsight analysis and is improper. Applicant asserts that there is no suggestion, other than solely in Applicant’s specification, that the combined teachings of the Oh reference and the Taniguchi reference will have a reasonable expectation of success. Additionally, the only suggestion to combine the teachings of the Oh reference and the Taniguchi reference is in Applicant’s specification, which thing cannot be relied upon to form an obviousness rejection. Such a rejection is neither within the ambit nor purview of 35 U.S.C. § 103 and cannot establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. Further, Applicant asserts that any combination of such prior art cannot and does not teach or suggest the claim limitations of presently amended independent claims 1

and 13 because any rejection based on any combination of such prior art would be a hindsight reconstruction of the presently claimed invention by picking and choosing elements and claim limitations based solely upon Applicant's disclosure because the cited prior art is devoid of any teaching or suggestion for any combination thereof. Since all rejections of the claimed inventions are based upon the Oh reference and the Taniguchi reference, Applicant asserts that the use of such prior art is *prima facie* evidence that there is no prior art that contains any teaching or suggestion of the claim limitations of the claimed inventions of independent claims 1 and 13, otherwise, other individual prior art references would have been used in any rejection, which references would teach or suggest the claimed inventions.

For these reasons, Applicant respectfully submits that, under 35 U.S.C. § 103, independent claims 1 and 13 and the dependent claims therefrom are allowable over the combination of the Oh reference and the Taniguchi reference because, at the very least, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103.

Obviousness Rejection Based on Ibiden Co Ltd (JP404113663A) in View of Oh (U.S. Patent 5,352,107) and in View of Owens (U.S. Patent 6,465,743) and in View of Keenan (U.S. Patent 3,767,304)

Claims 1, 3 through 6, 13, and 15 through 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ibiden Co Ltd (JP404113663A) in view of Oh (U.S. Patent 5,352,107) and in view of Owens (U.S. Patent 6,465,743) and in view of Keenan (U.S. Patent 3,767,304). Applicant respectfully traverses this rejection, as hereinafter set forth.

Again, Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Turning to the cited prior art, the Ibiden Co Ltd teaches or suggests using laser to remove burrs from a lead frame having an electronic component as subsequently sealing a portion of the lead frame and electronic component in a transfer molding machine.

The Oh reference teaches or suggests the use of an apparatus for sensing incomplete molding of an automold system in process for molding semiconductor packages.

The Owens reference teaches or suggests a molded ball grid array package.

The Keenan reference teaches or suggests an apparatus for detecting the presence of inclusions in semiconductor material using a polychromatic light source.

Applicant asserts that any combination of the Ibiden Co Ltd reference in view of the Oh reference in further view of the Owens reference and in yet further view of the Keenan reference fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of independent claims 1 and 13 because any combination of such cited prior art fails to teach or suggest all the claim limitations of independent claims 1 and 13. Applicant asserts that any combination of the cited prior art fails to teach or suggest the claim limitations of independent claims 1 and 13 calling for "removing at least a portion of the resist from the substrate using the laser used in the automolding system", "placing the substrate in the molding portion of the automolding system for encapsulation of a portion thereof", "laser etching the resist from at least a portion of the surface of the substrate using the laser in the automolding system", and "encapsulating the substrate in the molding portion of the automolding system".

Applicant respectfully submits there is no suggestion or motivation, either the Ibiden Co Ltd reference or the Oh reference or the Owens reference or the Keenan reference, to modify any of the reference or to combine reference teachings to form the claimed invention to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. The Ibiden Co Ltd reference merely teaches or suggests the use of a laser and subsequent automolding of a part while the Oh reference merely teaches or suggests the use of automolding systems while the Owens reference teaches or suggests a molded ball grid array package and the Keenan reference teaches or suggests an apparatus for detecting the presence of inclusions in semiconductor material using a polychromatic light source.

Applicant respectfully submits that such analysis is merely hindsight analysis and is improper. Applicant asserts that there is no suggestion, other than solely in Applicant's specification, that the combined teachings of the Ibiden Co Ltd reference in view of the Oh reference in further view of the Owens reference and in yet further view of the Keenan reference will have a reasonable expectation of success. Additionally, the only suggestion to combine the teachings of the Ibiden Co Ltd reference in view of the Oh reference in further view of the Owens reference and in yet further view of the Keenan reference is in Applicant's specification, which thing cannot be relied upon to form an obviousness rejection. Such a rejection is neither within the ambit nor purview of 35 U.S.C. § 103 and cannot establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. Further, Applicant asserts that any combination of such prior art cannot and does not teach or suggest the claim limitations of presently amended independent claims 1 and 13 because any rejection based on any combination of such prior art would be a hindsight reconstruction of the presently claimed invention by picking and choosing elements and claim limitations based solely upon Applicant's disclosure because the cited prior art is devoid of any teaching or suggestion for any combination thereof. Since all rejections of the claimed inventions are based upon the Ibiden Co Ltd reference in view of the Oh reference in further view of the Owens reference and in yet further view of the Keenan reference, Applicant asserts that the use of such prior art is *prima facie* evidence that there is no prior art that contains any teaching or suggestion of the claim limitations of the claimed inventions of independent claims 1 and 13, otherwise, other individual prior art references would have been used in any rejection, which references would teach or suggest the claimed inventions.

For these reasons, Applicant respectfully submits that, under 35 U.S.C. § 103, independent claims 1 and 13 and the dependent claims therefrom are allowable over the combination of the Ibiden Co Ltd reference in view of the Oh reference in further view of the Owens reference and in yet further view of the Keenan reference because, at the very least, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103.

Applicant submits that claims 1, 3 through 6, 13, and 15 through 18 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 1, 3 through 6, 13, and 15 through 18 and the case passed for issue.

Respectfully submitted,



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